

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed November 16, 2004. No amendments have been made. Applicant respectfully provides these remarks.

The Restriction Requirement is Improper

The Examiner finalized the restriction to one of the following groups:

- I. Claims 1-8 and 26 drawn to a method of generating an order plan;
- II. Claims 9-16 and 25 drawn to a system of generating an order plan; and
- III. Claims 17-24 drawn to logic for generating an order plan.

Applicant again respectfully traverses the restriction requirement, and provides the following remarks in response to the Examiner's argument to finalize the restriction requirement. As discussed in a previous Response filed August 4, 2004, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is required. M.P.E.P. § 803.

First, the inventions are neither independent nor distinct. As shown in the previous Response, the inventions are neither independent nor distinct. To avoid burdening the record, Applicant does not explicitly repeat those arguments in this Response; however, Applicant does incorporate those arguments by reference herein.

To show that the invention of Groups II and III are distinct, the Examiner argues that the inventions of Groups II and III are related as subcombinations that are distinct from each other because they are separately usable. The Examiner states that the invention of Group III has a separate utility "such as the medium on which the logic is written can alternatively be used as a device on which music is recorded and played." (Office Action, Page 2) However, the inventions are not separately usable. First, Claim 17 plainly recites logic encoded in media, not the media itself, so even if the media itself could be separately usable it would still have no bearing on whether the logic is separately usable. Second, Claim 17 plainly recites logic for generating an order plan in the context of a supply chain network, which could not conceivably be usable for recording and playing music. Accordingly, the other use suggested

by the Examiner is not reasonable. If applicant proves or provides an argument, supported by facts, that the other use suggested by the Examiner cannot be accomplished or is not reasonable, the burden is on the Examiner to document a viable alternative use or withdraw the requirement. M.P.E.P. § 805.06(d). Applicant respectfully requests that the Examiner document a viable alternative use for the claimed logic for generating an order plan in the context of a supply chain network (as opposed to the media on which the logic is encoded) or withdraw the restriction requirement.

Furthermore, in the previous Response, Applicant expressly admitted that the claims of Groups I, II, and III are obvious over each other. (Response filed August 4, 2004, Page 11, Paragraph 1) "If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required." M.P.E.P. § 803 (citation omitted). Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction requirement.

Second, as in the previous Response, the search and examination of the application may be made without serious burden on the Examiner. First, the claims of Groups I, II, and III clearly recite substantially similar limitations, as shown in the previous Response. Second, there are only two independent claims that are included in Group III related to Class 705, so providing reasons for allowance for each and every independent claim of Group II would not pose a serious burden on the Examiner. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803.

Although Applicant appreciates the opportunity to obtain multiple patents for the present invention, in light of the substantial similarities among the claims, as discussed above, and the substantial costs associated with prosecuting multiple applications, Applicant must respectfully traverse the Examiner's restriction requirement.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement and reinstatement of the withdrawn claims. Applicant reserves the right to petition the restriction requirement if it is maintained.

The Claims are Allowable over *Kennedy* and *Milne*

The Examiner rejects Claims 17-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,047,290 to Kennedy et al. ("*Kennedy*") in view of U.S. Patent 6,049,742 to Milne et al. ("*Milne*"). Applicant respectfully disagrees.

A. Independent Claim 17

1. The proposed *Kennedy-Milne* combination fails to meet limitations recited in independent Claim 17

Kennedy fails to disclose, teach, or suggest numerous limitations specifically recited in Applicant's independent Claim 17. For example, *Kennedy* fails to disclose, teach, or suggest at least the following limitations specifically recited in independent Claim 17:

for *each priority level*:

for *each item request of a priority level*:

plan an order for an item request of a current priority level according to a plurality of recorded unplannable network components, an unplannable network component being unable to satisfy an item request; and

determine the unplannable network components for the current priority level;

validate the unplannable network components; and

record the validated unplannable network components for the current priority level.

As discussed in the previous Response, *Kennedy* discloses first *prioritizing upstream consumer objects to reflect customer priorities during upstream planning*, and then *determining resource allocation according to the prioritized upstream consumer objects during downstream planning*. Even passages relied upon by the Examiner support such an interpretation of *Kennedy*:

Customer requests can consist of an end item, quantity, due date (or period), and potentially many attributes such as priority which a flow policy might want to reference in determining how to plan consumers given finite resources. For example, a flow policy might be able to build only enough producers to deliver to nine of ten consumers on time. Thus, it must decide which consumer falls late. A low priority or later due date would be good criteria for making a consumer late.

(Column 3, Lines 25-31) For the Car and Truck buffers 40 and 60, the user can specify, for example, two criteria: the customer priority (either "High" or "Low") and the type of order (either "Actual" or "Forecast"). (Column 4, Lines 35-38)

The Examiner argues that *Kennedy* discloses a system that contemplates “a network component which is unplannable, e.g. unable to satisfy a request for a given priority level (e.g. HIGH/LOW see col. 4 lines 36-37) in that only 9/10 customers will have the good.” (Office Action, Page 6, Paragraph 1)

Applicant respectfully submits that *Kennedy* still fails to disclose, teach, or suggest all the limitations specifically recited in Applicant's independent Claim 17. The prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. M.P.E.P. § 2142 (emphasis added); *see also* M.P.E.P. § 2143.03. “***All words in a claim must be considered*** in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (emphasis added).

As discussed above, *Kennedy* discloses first ***prioritizing upstream consumer objects during upstream planning***, and then ***determining resource allocation according to the prioritization during downstream planning***. *Kennedy* also discloses using priority ***during the downstream planning*** to determine which consumer falls late. *Kennedy*, however, fails to disclose, teach, or suggest ***selecting a current priority level***, planning for the current priority level, and recording information to be used for planning the ***next selected priority level***. Thus, *Kennedy* fails to disclose, teach, or suggest any type of ***planning for each priority level***, much less ***selecting customer requests*** of a current priority level, ***planning*** for the selected customer requests of the current priority level, ***determining unplannable producer objects*** for the current priority level, and ***recording the producer objects*** as unplannable for the current priority level for a next priority level.

Accordingly, *Kennedy* cannot disclose, teach, or suggest at least the following limitations specifically recited in independent Claim 17:

for ***each priority level***:

for ***each item request of a priority level***:

plan an order for an item request of a current priority level according to a plurality of recorded unplannable network components, an unplannable network component being unable to satisfy an item request; and

determine the unplannable network components for the current priority level;

Kennedy similarly does not disclose, teach, or suggest, as specifically recited in independent Claim 17:

for each priority level:

*...
validate the unplannable network components; and
record the validated unplannable network components for the current priority level.*

The Examiner relies on Official Notice as to these limitations. Specifically, the Examiner states, "The steps of validating and recording the validated ... unplannable network components for the current priority level is deemed an old and notorious step and official notice is hereby taken thereof lending no patentable weight to the claims." (Office Action, page 4) The Examiner provides U.S. Patent No. 6,091,362 to *Stilp et al* ("*Stilp*") in support of his position.

Applicant maintains the traversal of the Official Notice taken by the Examiner because *Stilp* fails to support the Examiner's position. *Stilp* discloses a wireless location system that receives signals transmitted by wireless telephones at a plurality of signal collection system sites. The Examiner refers to the following passage of *Stilp*: "ApDbRecvLoc starts ten threads that each retrieve location records from shared memory, validate each record before inserting the records into the database, and then inserts the records into the correct location record partition in the database." (Column 36, lines 56-60) *Stilp*, however, does not mention unplannable network components, and thus cannot support the Examiner's Official Notice that validating and recording the validated unplannable network components for the current priority level is "an old and notorious step." Accordingly, Applicant maintains the traversal of the Official Notice taken by the Examiner.

Thus, *Kennedy* still also fails to disclose, teach, or suggest, as specifically recited in independent Claim 17:

for *each priority level*:

...
validate the unplannable network components; and
record the validated unplannable network components for the
current priority level.

Milne fails to make up for the deficiencies of *Kennedy* discussed above. The Examiner has rightly not alleged that *Milne* does disclose, teach, or suggest these missing limitations.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 17 and its dependent claims.

2. The proposed *Kennedy-Milne* combination is improper

Even if it would have been technologically feasible at the time of the invention to combine the teachings of *Kennedy* and *Milne*, which Applicant does not admit, the rejection would still be improper because the Examiner still has not shown the required teaching, suggestion, or motivation in *Kennedy*, in *Milne*, or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Kennedy* with *Milne* in the manner the Examiner proposes. Independent Claim 17 is also allowable for at least this additional reason.

Nothing in *Kennedy*, *Milne*, or knowledge generally available to those of ordinary skill in the art at the time of the invention teaches, suggests, or motivates in any way the proposed combination. As discussed in the previous Response, the Examiner's speculation that "it would be obvious" to one of ordinary skill in the art to combine the teachings of *Kennedy* and *Milne* to achieve Applicant's invention, in hindsight with the benefit of Applicant's claims as a roadmap for selecting portions of multiple references, is clearly insufficient under the M.P.E.P. and the governing Federal Circuit case law. Moreover, the Examiner's conclusory statement that the "There is clear motivation for such a combination because both patents deal with insuring of managing the probability of the availability of

product to an end user” is directly at odds with the governing M.P.E.P. and Federal Circuit guidelines discussed in the previous Response. The fact remains that the prior art simply fails to provide the requisite teaching, suggestion, or motivation to combine *Kennedy* with *Milne* in the manner the Examiner proposes.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 17 and its dependent claims.

B. Dependent Claims 18-24

Dependent Claims 18-24 are allowable based at least on their dependency on independent Claim 17. Since Applicant believes he has amply demonstrated the allowability of the independent claim over the prior art, and to avoid unnecessarily burdening the record, Applicant has not provided detailed remarks concerning the dependent claims. However, Applicant remains ready to provide such remarks in a future Response or on Appeal, if appropriate. Applicant respectfully requests reconsideration and allowance of all dependent claims.

C. Withdrawn Claims 1-16, 25, and 26

If Claims 1-16, 25, and 26 are reinstated, as they should be for the reasons set forth above, the claims are allowable for at least the same reasons as Claim 17 and its dependent claims.

Conclusion

Applicant believes this case is in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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